

REMARKS

In the Official Action dated 09/08/2005 and in the final rejection dated 02/24/2006, claims 60 and 61 were rejected under 35 U.S.C. 102(a) as being anticipated by BOLERO, article I pages 21-22 and article II pages 85-88. We submit that it is clear from reading those two actions that the Examiner was basing his rejection on the BOLERO articles and not the BOLERO project per se. In response to that rejection, applicant pointed out that two BOLERO articles are dated after the applicant's priority dates (8 February 1995 and May 1995).

Then, in the Advisory Action dated 6/22/2006, the Examiner contended that claims 60 and 61 were being rejected "based on the BOLERO project not on the articles" even though he goes on to refer to the contents of the articles. But in any event, 35 U.S.C. § 102 specifies

"A person should be entitled to a patent unless-(a) the invention was known or used by others in this country..."

The Bolero project was carried out in Europe for the European Commission. Applicant at applicant's company, Cryptomathic A/S, designed the security and the authorization aspects of the BOLERO project and they were and are located in Europe, not the United States. Thus any knowledge about the security and authorization features of BOLERO acquired by any of the project's U.S. participants originated overseas. We submit that any such U.S. participants do not constitute the "others in this country" contemplated by 35 U.S. § 102(a).

Further, as noted by the Examiner in paragraph 11 cont. of the Advisory Action, the Bolero project was operated on a trial basis from July to September, 1995 which is after applicant's priority dates. Finally, applicant's Declaration filed on May 9, 2006 clearly states that he knows of no use or publication of his claimed invention prior to his priority dates.

Thus we submit that even if the Examiner is relying on the knowledge and use portion of 35 U.S.C. § 102(a), there is no suggestion anywhere in the record that the BOLERO project was known or used "by others in this country" within the meaning of that statute. Therefore, BOLERO, be it the articles or the project, is not prior art as a matter of law.

However, even if BOLERO should be deemed to be prior to applicant's priority dates, it does not disclose the subject matter of claims 60 and 61.

Claim 60 now specifies:

A method of electronically negotiating an END, sold by a seller to a buyer, in which the buyer splits the END electronically into two or more parts and then negotiates those parts separately to one or more further buyers without the involvement of a trusted third party (TTP).

Claim 61 requires:

A method according to claim 60, in which each part is subjected to the digital signature of the document carrier hardware of said buyer which effects the splitting.

To further distinguish the claim 60 method from the BOLERO project, that claim now specifies that the splitting and negotiating steps are carried out without the involvement of a trusted third party (TTP). As noted on specification page 2, penultimate paragraph, the requirement of a TTP is undesirable because it imposes a heavy liability burden. The BOLERO project required multiple TTPs operated by neutral parties.

In the paragraph 11 cont. of the Advisory Action, the Examiner sets forth some generalized statements about BOLERO articles I and II, but nothing about the steps in claim 60 in which the buyer splits the END electronically into two or more parts and then negotiates those parts separately to one or more further buyers without the involvement of a trusted third party (TTP). Nor is there any teaching that each part is subjected to the digital signature of the document carrier hardware of the buyer which effects the splitting as called for by claim 61.

In that same paragraph of the Advisory Action, the Examiner goes on to state:

“Applicant’s disclosure indicates, that ‘so-called’ splitting ‘of a purchased cheque’ by purchasing cheque and splitting it into two by means of two digital signatures by the buyer is well known (see page 12 last paragraph).”

Applicant’s specification page 12, last paragraph, indicates no such thing. On the contrary, at specification pages 12 and 13, applicant is describing his invention as applied to electronic bank cheques, not the prior art. Nowhere does it suggest there that any kind of splitting is “well known”, let alone a splitting without a TTP as specified in claims 60 and 61.

Thus, we contend that the rejection of claims 60 and 61 as being anticipated by BOLERO, either the articles or the project, is unwarranted.

At the end of paragraph 11 cont. of the Advisory Action dated 06/22/2006, the Examiner stated that “applicant should submit the information [about BOLERO] as a prior art because the information is relevant to the claimed invention.”

Applicant has already submitted all the documents in his possession about the BOLERO project except portions of the original Bolero Phase II proposal marked “COMMERCIAL IN CONFIDENCE” sent to the European Commission in 1994 which he recently found in his attic after much searching in response to the Examiner’s requirement for information. This is being submitted with a Third IDS enclosed herewith. It should be borne in mind that his BOLERO activity occurred over 10 years ago and his records relating thereto were disposed of a long time ago. Applicant’s attorneys have carried out a web search regarding BOLERO, and relevant documents developed thereby are also identified in the enclosed Third IDS. The earliest document found is the BOLERO Final Report, dated June 10, 1995. Other documents include the Final Report of European Trusted Services (ETS) Results of 1995 TTPS Projects, dated April 1997 which discusses BOLERO at paragraph 2.4 and a dissertation entitled “New Attempts at Electronic Documentation in Transport Bolero-The end of the Experiment, the beginning of the future?”, dated 15 April 2001; see pages 12-13.

None of these documents indicate that the BOLERO project included splitting an END. Moreover, it is apparent from all of these documents that BOLERO required the

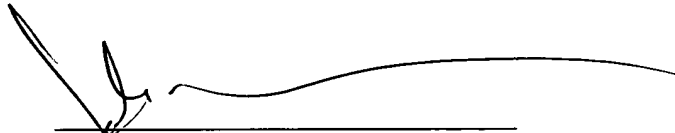
involvement of a trusted third party (TTP) (as a witness) in each transaction to prevent double spending. Applicant's claimed method does not involve a TTP.

Any additional documents that the Examiner may request or require from applicant relating to the BOLERO project are unknown or not readily available to applicant.

We submit that applicant has satisfied his burden of proving that claims 60 and 61 are allowable over the prior art of record and we request reconsideration to that end.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John F. McKenna', is written over a horizontal line. The signature is stylized with a large, sweeping 'J' and 'M'.

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Current Claims Schedule

1 1-59 (Cancelled).

1 60. (Currently Amended) A method of electronically negotiating an END, sold by a
2 seller to a buyer, in which the buyer splits the END electronically into two or more parts
3 and then negotiates those parts separately to one or more further buyers- without the in-
4 volvement of a trusted third party (TTP).

1 61. (Previously Presented) A method according to Claim 60, in which each part is sub-
2 jected to the digital signature of the document carrier hardware of said buyer which ef-
3 fects the splitting.